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No. 83-2084

In the Supreme Court of the United States

OCTOBER TERM, 1983

LESLIE C. CASE,

Petitioner,

vs.

CPC INTERNATIONAL INC. and
COMMISSIONER OF PATENTS AND TRADEMARKS,

Respondents.

On Petition for Writ of Certiorari to the
United States Court of Appeals for the Federal Circuit

BRIEF FOR RESPONDENT CPC INTERNATIONAL INC. IN OPPOSITION

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RULE 28.1 STATEMENT

Respondent CPC International Inc. has no parent companies, subsidiaries (apart from wholly-owned subsidiaries) or affiliates.

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This petition presents no question warranting this Court's attention.

Petitioner notwithstanding, the Court of Appeals decided this case in accordance with principles of law which (a) have been long settled and (b) are well grounded in the patent law.

This brief for respondent will begin with a counter-statement of the facts, since petitioner has not stated the case either fully or fairly.

COUNTERSTATEMENT OF THE CASE

A. The Parties And The Issues.

This case arises from an interference proceeding decided by the United States Patent and Trademark Office in October of 1976. Petitioner is the inventor and owner of U.S. patent No. 3,510,471, issued on an application filed in the Patent and Trademark Office on March 9, 1967. It discloses and claims a complex chemical composition of a polyether polyol produced from a polysaccharide such as starch.

Respondent CPC International Inc. (hereinafter "CPC") is the owner, by assignment of Dr. Hyman M. Molotsky, of a pending patent application Serial No. 105,684, accorded an effective filing date of January 3, 1967.* Because the CPC application disclosed, in the view of the Patent and Trademark Office, substantially the same composition, the Patent Office instituted pursuant to Title 35, United States Code, §135, an interference proceeding between petitioner's patent and respondent's application to determine who, as between petitioner and Molotsky, was the first inventor.

B. The Case Patent.

Petitioner's patent claims a mixture prepared by reacting (a) a polyalcohol such as glycerin and (b) a polysaccharide such as starch with a compound known as an

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* The CPC application was, in fact, filed on January 11, 1971. Since it included the same subject matter as had been disclosed in application Serial No. 606,596, which had been filed in January of 1967, the later application, called a continuation-in-part, was given the effective filing date of the first application under Title 35, United States Code, §120.

alkylene oxide. That reaction is referred to by chemists as an oxyalkylation reaction and produces an oxyalkylated alcohol in admixture with an oxyalkylated polysaccharide.

Petitioner's claim 1 describes a class of polyalcohols used in carrying out that oxyalkylation reaction. He defines them as aliphatic alcohols containing 3-9 carbon atoms and a minimum of 3 alcohol or hydroxy groups. Glycerin is the simplest alcohol of that group.

Similarly, the polysaccharides used by petitioner are described as containing at least 3 saccharide units per molecule. Starch, of course, meets that definition, containing several hundred such units.

Petitioner's patent says that the number of alkylene oxide groups reacted with each of the polysaccharide and the polyalcohol ranges from about 1.0 to about 3.0 on the average. The proportions between the polysaccharide and the polyalcohol are such that the oxyalkylated polyalcohol makes up 10-95% by weight of the mixture while the oxyalkylated polysaccharide represents the remainder, 90-5% of the composition.

C. The First Molotsky Application.

Respondent's first application, Serial No. 606,596, was filed on January 3, 1967 in the name of Hyman M. Molotsky as the inventor. In essence, it describes oxyalkylated starches prepared by reaction of an alkylene oxide with starch in the presence of a solvent.

The '596 application, like petitioner's patent, teaches the proportion of alkylene oxide used, calling for a "molar substitution" ranging from about 3.5 to about 50. That

range corresponds to a number of alkylene oxide units reacted with the starch within the range of about 1.1 to about 17 — thus overlapping petitioner's claimed range of about 1.0 to 3.0.

Respondent's '596 application teaches that starch can be reacted with the alkylene oxide in the presence of a reactive solvent like glycerin. Example 6 of the application is a specific embodiment describing a polyether polyol prepared by reaction of starch and glycerin with propylene oxide.

As the Patent Office and the courts below concluded, Example 6 falls squarely within the claims of petitioner's patent.

D. Molotsky's C-I-P Application.

Respondent, in January of 1971, refiled the '596 application as a continuation-in-part. The latter application was given Serial No. 105,684 with a filing date of January 11, 1971.

The '684 application contained all of the same disclosure as the original application — including Example 6 — as well as newly-added disclosure.

E. The Declaration Of The Interference.

Because petitioner's complaint stems from the procedures followed by the Patent Office in instituting an interference proceeding, we shall, with due regard for brevity, briefly describe that procedure.

Under Patent Office rules regarding interference procedure, an applicant, to provoke an interference with a patent, must submit claims in his application which are

"copied or substantially copied" from the patent (37 CFR §1.205(b)). Because respondent did not define its invention in the same words as did petitioner, respondent could not support petitioner's patent claims verbatim, and notably the definition of the alcohol as containing 3-9 carbon atoms and at least 3 hydroxy groups. However, respondent did disclose several alcohols which met petitioner's definition, and hence could nonetheless present a claim defining the same invention, albeit in different terms.

The Patent Office therefore suggested that respondent present claims in its application which defined the same invention as called for by petitioner's patent, but using language which respondent's application could support. Respondent did just that, presenting claims which embrace a polyether polyol prepared by reaction of starch and glycerin with an alkylene oxide.

The Patent Office thus instituted an interference between the Molotsky application and petitioner's patent. Since the "count" of the interference — a claim which defines the interfering subject matter — must embrace both the application claim and the patent claim, the Patent Office formulated, as count 1, a count just like petitioner's claim 1, except that it did not include the proportions of the oxyalkylated polyalcohol and the oxyalkylated polysaccharide. The Patent Office examiner ruled that those proportions amounted to "an immaterial limitation" in Petitioner's claims within the meaning of 37 CFR §1.205(a).

The Examiner's holding was affirmed by the Board of Patent Interferences. The Board awarded priority of the counts to respondent, relying on petitioner's never having

attempted to prove any date of invention prior to his filing date. The Board thus concluded that because respondent's application had an earlier filing date evidencing constructive reduction to practice of the subject matter disclosed in that application, respondent was entitled to prevail.*

The Board of Patent Interferences specifically rejected the points which petitioner asserts here. Thus:

(1) The Board dismissed petitioner's contention that his patent claim defined different inventions because the latter did not include the proportions of oxyalkylated polyalcohol and oxyalkylated polysaccharide. Recognizing that, notwithstanding the difference in wording, the invention claimed by petitioner was the same as that disclosed by respondent, the Board noted (A 10):

> "It is thus apparent that both Case and Molotsky disclose carrying out the same reaction so that both necessarily obtain the same product."

(2) The Board rejected petitioner's argument that the counts were improperly constituted in failing to recite the proportions of the two components, noting that petitioner had failed to carry his burden of proving that proportions outside the patent claims but within the counts represented a patentably different invention.

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* It is settled law that the filing of a patent application is constructive reduction to practice of the subject matter disclosed in it. A party seeking to prove an earlier date for that subject matter must show, by competent evidence, that he in fact made the invention on a date earlier than his filing date. See, for example, *Beeber* v. *Krogh,* 403 F.2d 743, 745 (CCPA, 1968).

F. The Decision Of The District Court.

The District Court, after a full trial on the merits, dismissed petitioner's complaint, finding that respondent was entitled to prevail as a matter of law. The District Court, like the Patent Office before it, resolved the matter on the basis that petitioner, establishing no date of invention prior to his March 1967 filing date, had failed to antedate respondent's filing date of January 1967.

The District Court rejected as legally unfounded petitioner's argument that respondent had to copy petitioner's patent claim verbatim. Relying on the decision of the Court of Customs and Patent Appeals in *Squires* v. *Corbett,* 560 F.2d 424 (CCPA, 1977), the District Court held that respondent need only present claims directed to the same invention as petitioner's patent claims.

While noting that petitioner argued that his patent claims were directed to a different invention, the District Court dismissed that argument, observing that petitioner had failed to carry his burden of proof on that issue. In that regard, the District Court relied on the expert testimony of Dr. Stanley M. Parmerter. The District Court, noting that Parmerter's testimony was in conflict with that advanced by petitioner himself, adjudged Parmerter to be worthy of belief, and rejected petitioner's testimony as incredible.*

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* The District Court was so persuaded by Parmerter's testimony that it adopted Parmerter's testimony "as part of my findings" (A 40).

G. The Decision Of The Court Of Appeals.

The Court of Appeals, relying on long-standing precedent of its predecessor Court of Customs and Patent Appeals, affirmed the judgment of the District Court.

Respecting petitioner's contention that his invention was somehow different from that disclosed in respondent's application because the count did not include the proportions of components, the Court held that petitioner had simply failed to carry his burden of persuasion that somehow those omitted limitations were material. It rejected outright petitioner's contention, reiterated in his Petition, that an interference can be declared only if an applicant copies patent claims verbatim.

Argument

The facts themselves make a compelling showing that there is involved here no matter warranting this Court's attention. Indeed, this case was a routine patent interference in which petitioner, as junior party, failed to establish that he had made his invention before respondent did. Petitioner's loss in the courts below was, in reality, occasioned by a failure of proof, rather than any defect in the procedures followed, as will now be shown.

I. The Statute Not Only Authorizes But Compels The Patent Office To Follow The Procedures Criticized In This Case.

The starting point for an analysis of the procedures followed by the Patent Office in this case is Title 35, United States Code, §135, providing that whenever a patent application "in the opinion of the Commissioner, would interfere with any pending application, or any unexpired patent", the Commissioner shall give notice and determine, through the Board of Patent Interferences, the question of priority of invention.

The statute addresses explicitly the very point which petitioner here raises as violative of the law, namely that §135(b) calls for an interference when an application claim is "the same as, or for the same or substantially the same subject matter as" a patent claim. In other words, the statute says that an interference shall be declared when the claims are for the same invention *or substantially the same* invention.

That same policy is carried through in the rules promulgated by the Commissioner of Patents, and notably 37

CFR §1.205 which petitioner attacks here. §1.205 provides that a claim should be "copied or substantially copied" from a patent. That sets at naught any requirement imagined by Petitioner that an application copying a patent claim must copy that claim verbatim.

All else aside, this Court has long since recognized that a numerical range in a patent claim normally does not set it apart as a separate invention. A numerical limitation must correspond to a newly-discovered physical phenomenon before it can set that claim apart from the prior art. *Dow Chemical Co.* v. *Halliburton Oil Well Cementing Co.*, 324 U.S. 320, 329 (1945) That is yet a further reason why the omitted proportions, which Petitioner relies on so heavily, cannot distinguish his invention from that of Respondent.

In sum, there is just no substance to Petitioner's argument that there was a failure to "declare and conduct the interference in accordance with the rules" (Petition, p. 21).*

II. The Other Arguments Advanced By Petitioner Are Equally Groundless.

Petitioner's other ground for seeking review in this Court is that the practices followed in the Patent Office and the courts below are gravely injurious to the public.

That, as an argument, just will not wash. Rather than being injurious to the public, the procedures followed here prevent the public from being subjected to two patents on

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* Having shown that the Patent Office and the courts below did properly resolve the question of priority, the other points raised by Petitioner are moot.

inventions which are the same, though expressed in somewhat different claim language. Indeed, had the Patent Office and the courts below viewed this case in any other way, as Petitioner urges, there would be two patents on the books, owned by separate parties and each covering a polyether polyol prepared by reaction of starch, glycerin and an alkylene oxide.

Conclusion

The petition here is utterly lacking in merit, and should be denied.

Respectfully submitted,

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